

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

H28443 (MOR03334P02090US)

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Application Number

10/772,560

Filed

February 5, 2004

First Named Inventor

Patricia Lewis et al

Art Unit

3634

Examiner

Alvin C. Chin Shue

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



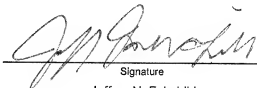
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Registration number if acting under 37 CFR 1.34 _____



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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.



*Total of 2 forms are submitted.

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STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1, 2 and 11-16 are pending and at issue.

Claims 1, 2 and 11 stand rejected under 35 USC §103(a) as unpatentable over Hengstenberger et al. (US 4,682,671) in view of Nunn et al. (US 2,758,769) and Schoenbrun (US 6,447,037). Claims 12-16 stand rejected as unpatentable over Hengstenberger et al. in view of Nunn et al. and Schoenbrun, as applied to claim 1, and further in view of Crouch.

The clear error in the rejection is that it improperly modifies the references relied on in the rejection contrary to at least three express provisions of the MPEP and the case law.

The Proposed Modification Renders the Prior
Art Unsatisfactory for its Intended Purpose

The rejection is based upon an improper modification of Hengstenberger and Nunn et al. Specifically, Hengstenberger et al. is specifically directed towards providing "a safety harness which is self tightening and securing upon the wearer." (Column 1, lines 67-68). It achieves this by providing the safety harness having "a continuous loop of material connected to itself at a point to define a first large loop and a second smaller loop" (column 2, lines 13-16), so that "a pulling force on the handle loop 16 cinches or grips the wearer of the jacket 20 by placing opposing forces across the middle of the back

and the front of the shoulders, assuring that maximum engagement of the victim is achieved by the harness 10" (column 3, lines 40-44). Nunn et al. has as an express object to provide a harness for a child "that can be quickly applied and removed from the child, and which will not slide or fall from the child," (column 1, lines 32-33) and achieves this by utilizing its plate (13) to create a bite (19) such that the "bite 18 is pulled through bite 19; tightening the harness sufficiently to assure that it will not fall off" (column 2, lines 3-5) because "the friction between bites 18 and 19 is sufficient to retain the parts in an adjusted position and still permit the parts to be easily adjusted for removal or to assure the child's comfort." (Column 2, lines 25-28). However, the intended purpose for both Hengstenberger et al. and Nunn et al. would be completely defeated by the proposed modification which requires that the arm loops of Hengstenberger et al. as modified by Nunn et al. "be fixed at the stacked location, as taught by Schoenbrun, to enable fixed sized loops." This clearly would not allow the cinching and gripping discussed in Hengstenberger et al. and would certainly not allow the adjustment discussed in Nunn et al. Such modifications are strictly forbidden under the case law and the standards set forth in the MPEP (see MPEP 2143.01, V which states that "the proposed modification cannot render the prior art unsatisfactory for its intended purpose" and that "if the propose modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the purpose modification.") Accordingly, for this reason alone, the rejection is improper and should be withdrawn.

The Proposed Modification is Improper Because it Changes the Principle of Operation of Both Hengstenberger et al. and Nunn et al.

As previously discussed, the principle of operation for Hengstenberger et al. is that "a pulling force on the handle loops (16) cinches or grips the wearer of the jacket by placing opposing forces across the middle of the back and the front of the shoulders", and the principle operation for Nunn et al. is that "the bite 18 is pulled through the bite 19; tightening the harness sufficiently to assure that it will not fall off" and that "the friction between bites 18 and 19 is sufficient to retain the parts in adjusted position and still permit the parts to be easily adjusted for removal or to assure the child's comfort." The proposed modification fundamentally changes both these principles of operation by fixing the arm loops to each other at the stacked location so as to provide "fixed sized loops." Again, such a modification is expressly prohibited under the standards set forth in the case law and MPEP. (See MPEP §2143.01, VI stating that "the purpose modification cannot change the principle of operation of a reference" and that "if the purposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.") Accordingly, for this additional reason, the rejection is improper and should be withdrawn.

The rejection of claims 12-16 as unpatentable over Hengstenberger et al. in view of Nunn et al. and Schoenbrun, as applied to claim 1, and further in view of Crouch is improper for the reasons set forth above in connection with the rejection of claims 1, 2 and

11. Accordingly, for those reasons alone or together, the rejection of claims 12-16 are improper and should be withdrawn.

The Examiner's Answers in the Final Rejection Do Nothing
to Address Applicants' Arguments or to Overcome the
Express Prohibition Against the Proposed Modification

The Final Rejection responds to the above arguments by first inaccurately summarizing Applicants' argument as "the modification of Hengstenberger et al would be improper as Hengstenberger states that his harness is self-tightening and by pulling the handle 16, the loop 14 would grips the wearer of the jacket ensuring maximum engagement of the victim to pull the victim". In contrast to this summarization, Applicants quoted Hengstenberger accurately and cited the express language of Hengstenberger as follows:

Specifically, Hengstenberger et al. is specifically directed towards providing "a safety harness which is self tightening and securing upon the wearer." (Column 1, lines 67-68). It achieves this by providing the safety harness having "a continuous loop of material connected to itself at a point to define a first large loop and a second smaller loop" (column 2, lines 13-16), so that **"a pulling force on the handle loop 16 cinches or grips the wearer of the jacket 20 by placing opposing forces across the middle of the back and the front of the shoulders**, assuring that maximum engagement of the victim is achieved by the harness 10" (column 3, lines 40-44). (emphasis added)

It is noted that the Final Rejection's inaccurate summary conspicuously leaves out the express language bolded above, and particularly the express language that is underlined above. Perhaps this is because the proposed modification clearly prevents the principle

of operation and intended purpose shown by that express language. However, the express language quoted from Hengstenberger et al cannot simply be ignored in making a rejection.

Finally, the Final Rejection's assertions that the prior art references are "analogous arts" do absolutely nothing to overcome the express and absolute prohibitions in the MPEP against the type of modifications proposed in the rejections. MPEP §2143.01 VI states that "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE" and further that "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obviousness." Furthermore, MPEP §2143.01 V states that "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" and if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The language of these sections of the MPEP is clear and unambiguous and are an express prohibition against the type of modification proposed in the rejection, and the Final Rejection's assertions about "analogous art" are irrelevant to these express prohibitions.